

REMARKS

Upon entry of this amendment, claims 9-33 are pending. Claims 11 and 16 have been amended herewith.

Amendments to the Claims

Claim 11 has been amended as suggested in the Office Action by insertion of a comma between the words "fenbendazoles" and "lufenexons."

Claim 16 has been amended as suggested in the Office Action by removal of a duplicate comma after the word "ivermectin" and replacement of a period after the word "abamectin" with a comma.

No new matter has been added.

Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 9-20, 23-24, 26-28, and 31-32 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 4,799,921, issued to Johnson et al. in view of U.S. Patent Number 5,035,891, issued to Runkel et al., and further in view of U.S. Patent Number 4,847,243, issued to Wallace. Applicant respectfully disagrees.

Applicant notes that in order to establish a *prima facie* case of obviousness, the Examiner must show, among others things, a motivation to combine the references as well as a reasonable expectation of success in so doing. The motivation to combine must come from the references themselves or from knowledge commonly known in the art. The mere possibility that the references can be combined is not sufficient. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" MPEP 2143.01. Further, "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)." MPEP 2143.01. In the present case, the Examiner has provided no evidence that the prior art suggests the desirability of the combination that the Examiner cites. Rather, the Examiner

simply states that it would have been obvious to make the combination. Applicant submits that this is insufficient to establish a *prima facie* case of obviousness.

With respect to a reasonable expectation of success, the Examiner provides nothing the support a reasonable expectation of success in combining the cited references. Rather, the Examiner relies impermissibly on hindsight (having seen the present application) to put together the cited combination. The Applicant notes that the field of pharamcology is inherently more unpredictable than, for example, the mechanical arts. For example, before the present inventive activity by Applicant, the cited references give no reason to suggest that using ivermectin or a related avermectin within the controlled release implant of Runkel would result in the appropriate chemistry to lead to a viable treatment. This insight is only gained in hindsight by reviewing the present disclosure. Further, there is nothing in the cited references to suggest that combining an immediate release drug like ivermectin or a related avermectin, along with an extended release version of the same, would result in a useful product rather than a chemistry in which the two interfere with one another. Numerous other potential pitfalls loom over the prospect of combining the cited references to achieve something like the present invention, and it is only through hindsight, having knowledge of the contents of the present invention, that the Examiner is able to make the combination. As such, Applicant submits that the Examiner has not established a *prima facie* case of obviousness and respectfully requests that the above-rejection be withdrawn.

Applicant notes that claims 9, 14, 18, and 26, the independent claims pending in the present application, are patentable over the cited art for the reasons provided above. The remaining claims are therefore allowable dependencies on patentable base claims. Thus, Applicant submits that each and every claim currently pending in the present application is patentable in view of the arguments presented above.

CONCLUSION

Applicants respectfully request withdrawal of the rejections and believe that the claims as presented represent allowable subject matter. If the Examiner desires, Applicants welcome a telephone interview to expedite prosecution and is available at the telephone number below. Applicants believe there is no fee due at this time. However, the Commissioner is hereby authorized to charge any fees due to Deposit Account No. 19-3140.

Respectfully submitted,

Application No. 10/659,610 -
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